

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-12 are currently pending. No claims have been amended herewith.

In the outstanding Office Action, the specification was objected to for having a title that is not descriptive of the claimed invention; Claims 1-12 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claims 1-12 of U.S. Patent No. 6,700,614 to Hata (hereinafter “the ‘614 patent”); and Claims 1-12 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Applicant wishes to thank the Examiner for the interview granted Applicant’s representatives on February 1, 2007, at which time the rejections of Claims 1-12 under 35 U.S.C. § 112, first paragraph, were discussed. An agreement was reached that the rejection under 35 U.S.C. § 112 would be overcome if Applicant shows that the timing of the flash and the quantity of light in each flash is separately enabled in the specification, pending the Examiner’s further consideration of the claims upon formal submission of a response to the outstanding Office Action.

In response to the objection to the specification, the title of the invention has been amended to read “AUTOFOCUS APPARATUS HAVING A FLASH SYNCHRONIZED TO AN AUTOFOCUS SAMPLING TIME.” Accordingly, the objection to the specification is believed to have been overcome.

Regarding the rejection of Claim 1 on the ground of non-statutory double patenting, Applicant respectfully submits that the rejection is rendered moot by the Terminal Disclaimer filed herein.

Regarding the rejection of Claim 1 under 35 U.S.C. § 112, first paragraph, M.P.E.P.

§ 2163.05 states the following:

[a] claim that omits an element which applicant describes as an essential or critical feature of an invention originally disclosed does not comply with the written description requirement. See Gentry Gallery, 134 F.3d at 1480, 45 USPQ2d at 1503; In re Sus, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962).

In Gentry Gallery, the court's determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element – ‘control means’ – as ‘the only possible location’ and that variations were ‘outside the stated purpose of the invention.’ See Gentry Gallery, 134 F.3d at 1479. 45 USPQ2d at 1503.

Applicant's specification, however, does not describe that maintaining the light quantity of each flash substantially constant is an essential or critical feature of the invention originally disclosed. Furthermore, as discussed above, the Examiners indicated that the rejection would be overcome if enablement is shown, separately, for the timing and quantity of the flash. As set forth below, Applicant respectfully submits that the pending claims satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph.

Applicant's specification discloses that CPU 121 controls the light quantity of the flash tube Xe according to a charging signal, and controls synchronized flashing according to a flash timing signal.¹ Applicant submits that the disclosed separate CPU 121 control signals for the flash is sufficient to allow one of ordinary skill in the art to make and use the claimed invention without undue experimentation, i.e., to independently and separately control the synchronized flash timing and quantity in an autofocus apparatus. Particularly, one of ordinary skill in the art could, without undue experimentation, select an appropriate charging

¹ See Figures 1 and 2, “CPU 121”; pg. 8, line 21 – pg. 9, line 20; and pg. 18, line 21 – pg. 19, line 2.

signal² for controlling the flash, to output either a constant or varying light quantity, and to select an appropriate flashing timing signal³ to maintain synchronized flashing.

Additionally, M.P.E.P. § 2164.03 states the following:

[t]he scope of the required enablement varies inversely with the degree of predictability involved, but even in unpredictable arts, a disclosure of every operable species is not required. A single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements. In re Vickers, 141 F.2d 522, 526-27, 61 USPQ 122, 127 (CCPA 1944); In re Cook, 439 F.2d 730, 734, 167 USPQ 298, 301 (CCPA 1971).

Applicant further submits that the present claimed invention involves predictable factors (CPU controlled electrical elements) such that enablement should be interpreted broadly.

Accordingly, Applicant respectfully traverses the rejection of Claim 1 (and dependent Claims 2-6) as failing to comply with the written description requirement.

Claim 7 recites limitations analogous to the limitations recited in Claim 1.

Accordingly, for the reasons stated above for the patentability of Claim 1, Applicant respectfully traverses the rejection of Claim 7 (and dependent Claims 8-12) as failing to comply with the written description requirement.

² See Figure 2, "Charging Control" and pg. 8, line 21 – pg. 9, line 20.
³ See Figure 2, "Flash Timing" and pg. 8, line 21 – pg. 9, line 20.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to the effect is respectfully requested.

Respectfully submitted,

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